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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/878,874 | 06/11/2001 | Tony McCormack | 476-2028 | 2638 |

7590 08/23/2004

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EXAMINER

PATEL, HARESH N

ART UNIT PAPER NUMBER

2154

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,874

Applicant(s)

MCCORMACK ET AL

Examiner

Haresh Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 16-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-18 are presented for examination.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, are drawn to “establishing a telephone call at a specified time using an application by receiving the URI from another entity for instructing a telephony switch to set up a telephone call between the source and destination specified in the URI”, classified in class 709, subclass 204.
 - II. Claims 16 and 17, are drawn to “a web browser to parse uniform resource identifiers comprising time information”, classified in class 717, subclass 143.
 - III. Claim 18, is drawn to “a software application to create uniform resource identifiers (URIs) that are sent to other entities within the internet protocol communications network for the purposes of establishing a telephone call”, classified in class 717, subclass 103.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions I to III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such establishing a telephone call at a specified time using an application by receiving the URI from another entity for instructing a telephony switch to set up a telephone call between the source and destination specified in the URI, lacking one or more of the particulars of inventions II

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and III. Invention II has separate utility such as a web browser to parse uniform resource identifiers comprising time information, lacking one or more of the particulars of inventions of I and III. Invention III has separate utility such as a software application to create uniform resource identifiers (URIs) that are sent to other entities within the internet protocol communications network for the purposes of establishing a telephone call, one or more of the particulars of inventions of I and. See MPEP 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the extensive search required for one group is not required for the other groups, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. A telephone call was made to William M. Lee on August 17, 2004 to request an oral election to the above restriction requirement. William M. Lee elected invention I (Claims 1-15) without traverse.

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8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention, i.e., Group I. (37 CFR 1.143). Also applicant is requested to cancel claims 16, 17 and 18.

Specification

9. The disclosure is objected. Some of the informalities are:

- i. The "Brief summary of the invention" section should contain brief description of the disclosed subject matter rather repetitive claimed language of the claims.

10. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The present title is not sufficient for proper classification of the claimed subject matter. The following title is suggested: "An application to schedule web conference at received URI specified future timings".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art to ~~to~~ use and/or make the invention.

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12. The specification does not contain subject matter containing any software or hardware to implement limitation “automatically programming a feature key at a telephone terminal at one of the call source”, as cited in claim 9.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 8, 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 8, recites the limitation “a telephone call to one of the directory numbers”. There is insufficient antecedent basis for this limitation in the claim. It is not apparent which directory number is referred by “the directory number” of this limitation.

15. As cited in claim 9, the phrase “such as” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

16. As cited in claim 11, the claim is referring to steps without referring to a method and item (i) and item (ii) are not method steps but they are structure elements.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-8, 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et. al, Virtual room videoconferencing system, US 2003/0037109 A1, Feb. 20, 2003 (Hereinafter Newman) in view of applicant's admitted prior art (Hereinafter AAPA).

19. As per claim 1, Newman teaches a method of establishing a telephone call over a communications network at a specified time using a web-based telephony application (e.g., figure 6C, paragraph, 18, page 2), said method comprising the steps of:

(i) accessing a message comprising the specified time and also comprising information about a call source and destination (e.g. paragraph 64, page 4 and paragraph 17, pages 1-2); and (ii) at the time specified in the message, instructing a telephony switch to set up a telephone call between the source and destination specified in the message (e.g. paragraph 64, page 4 and paragraph 17, pages 1-2).

Newman also discloses use of directory name service (e.g., paragraph 64, page 4) and the messages that can be used to send or receive containing scheduling information (e.g., paragraph 84, page 6).

However Newman does not disclose use of uniform resource identifier (URI). The use of URI is well known in the art; AAPA, for example, discloses use of uniform resource identifier (URI) and Directory Number (DN) information (e.g., lines 15 – 18, page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Newman and AAPA in order to facilitate establishing a telephone call over a communications network at a specified time using a

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web-based telephony application using URI information. The motivation would be obvious because Newman clearly suggested that the messaging mechanism to schedule a teleconference could use any messaging means that can help schedule the teleconference. The well-known use of URI can help implement the messaging mechanism to send/receive messages among the devices used for establishing the telephone call over the communication network at a specified time using a web-based telephony application taught by Newman.

20. As per claim 2, Newman teaches the following:

receiving the message from another entity selected from a web site and a software application on a user terminal (e.g., paragraph 63, page 4).

21. As per claim 3, Newman teaches the following:

receiving the message from a web-based conference call booking application (e.g., figure 6C, paragraph, 18, page 2).

22. As per claim 4, Newman teaches the following:

accessing a message comprises receiving the message from a calendar application on a user terminal (e.g., figure 6C, paragraph, 18, page 2).

23. As per claim 5, Newman teaches the following:

said message comprises time zone information (e.g., figure 6A, paragraph, 68, page 5).

24. As per claim 6, Newman teaches the following:

said information about the call destination comprises a director number (DN) (e.g., paragraph 64, page 4, and paragraph, 68, page 5).

25. As per claim 7, Newman teaches the following:

said URI comprises a plurality of directory numbers and a plurality of time ranges, one for each directory number (e.g., paragraph 64, page 4, and paragraph, 68, page 5).

26. As per claim 8, Newman teaches the following:

instructing the telephony switch to set up a telephone call to one of the directory numbers depending on the current time and the time ranges (e.g., paragraph 64, page 4, and paragraph, 68, page 5).

27. As per claim 10, Newman teaches the following:

instructing the telephony switch to display the message at a telephone terminal at the call Source (e.g., paragraph 63, page 4).

28. As per claims 11-15, the claims are rejected for the same reasons as claims 1 to 8 and 10 above.

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29. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newman in view of AAPA and in further view of Grandgent et al, Audio conferencing system and method, U.S. 2003/0021400 A1, Jan. 30, 2003 (Hereinafter Grandgent).

30. As per claim 9, Newman and AAPA disclose the claimed limitation as rejected under claim 1. However, Newman and AAPA do not disclose, “automatically programming a feature key at a telephone terminal at one of the call source and call destination with the specified time such that the properties of that feature key change at the specified time”.

Grandgent discloses automatically programming a feature key at a telephone terminal at one of the call source (e.g., paragraph 82, page 5) and call destination with the specified time (e.g., paragraph 82, page 5) such that the properties of that feature key change at the specified time (e.g., paragraph 82, page 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Newman, AAPA and Grandgent in order to facilitate automatically updating properties supported by a feature key at a source/destination telephone terminal with the specified time. The motivation would be obvious because Newman and AAPA suggested, URIs containing information related to the specified time would be received by a source/destination telephone terminal (e.g., paragraph 82, page 5). The telephone terminal would help automatically update the properties that are supported by a feature key at the specified time, as suggested by Grandgent (e.g., paragraph 82, page 5).

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Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form PTO-892.

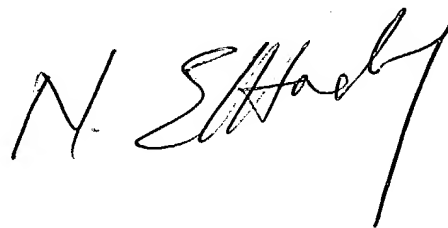
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is 703-605-5234. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 703-305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Haresh Patel

August 19, 2004

A handwritten signature in black ink, appearing to read "N. S. Haresh", with a long, sweeping vertical stroke extending downwards from the end of the name.